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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,323	06/06/2001	Dale Starkey	3833-010852	7514

423 7590 05/26/2005

HENKEL CORPORATION
THE TRIAD, SUITE 200
2200 RENAISSANCE BLVD.
GULPH MILLS, PA 19406

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/875,323

Applicant(s)

STARKEY, DALE

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3 and 5-15.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attachment.

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 10/29/02 and 11/17/03

13. ☐ Other: _____.

1. The finality of the Final rejection mailed March 15, 2005 is proper because the insertion of the limitations of cancelled claim 4 into independent claim 1 required a realignment of the 35 U.S.C. 103(a) rejection.
2. The 37 CFR 1.131 affidavit filed May 16, 2005 establishes a reduction to practice of the claimed subject matter before the filing date of November 17, 2000 for Shaddock Patent No. 6,518,600. Thus, Shaddock is no longer relied upon in the 35 U.S.C. 103(a) rejection.
3. Shimada et al. Patent No. 6,713,571 having a filing date of December 13, 2001 is antedated by the filing date for the instant application of June 6, 2001. Accordingly, Shimada et al. is also removed from the 35 U.S.C. 103(a) rejection.
4. The outstanding 35 U.S.C. 103(a) rejection is now based on Japanese Patent No. 52-15539 in view of Fetscher et al. Patent No. 3,849,383 and Landers, Jr. Patent No. 6,246,123.
5. The claims define the uniform distribution of the phosphor material "through partial curing of said epoxy resin composition." Example 1 on page 13 of the specification shows the partial curing, or B-staging of the composition which falls within the claimed limitation. Example 2 on pages 13-14 exhibits the pre-reaction of the phosphor with the epoxy composition followed by B-staging which is not representative of the claims since the claims merely necessitate partial curing. Therefore, the disclosure in Japanese Patent No. 52-15539 wherein "the reaction is stopped before reaching the curing temperature" constitutes a pre-reaction in the presence of the luminescent pigment.

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6. Japanese Patent No. 63-100391 cited in the previously unconsidered Information Disclosure Statement filed October 29, 2002 discloses a pre-cured composition of an epoxy resin, 4-methylhexahydrophthalic anhydride and phosphor which is subsequently cured. The reference is deemed to be particularly relevant to the claims.

7. Translations for Japanese Patent Nos. 52-15539 and 63-100391 have been ordered to further illuminate the details of the abstracts.

8. The specification on pages 3-4, paragraph 13 and page 9, paragraph 33 differentiates between the currently claimed partial curing, or B-staging, and the combination of pre-reaction and B-staging represented by Example 2. Amendment of claim 1 to pre-react the phosphor material with the epoxy composition followed by B-staging would not be considered at this stage of prosecution in the instant application due to the introduction of a new issue into the claims. However, such an amendment would be entertained in a continuing application such as a Request for Continued Examination at which time the full scope of the teachings of the Japanese patents could be determined via receipt of their translations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



Robert Sellers
Primary Examiner
Art Unit 1712